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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,888	12/19/2001	Jeffrey G. Nowlin	020375-006500US	2318
20350 7590 09/13/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER HAYES, JOHN W	
			ART UNIT 3628	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/028,888  
Filing Date: December 19, 2001  
Appellant(s): NOWLIN et al.

**MAILED**

**SEP 13 2007**

**GROUP 3600**

Jeffrey G. Nowlin et al.

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 30, 2004

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment filed 01 July 2004, concurrently with the Appeal Brief has been acknowledged, entered and has overcome the 112, second paragraph rejections in the office action mailed 04 May 2004.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that all pending claims, i.e. claims 1, 2, 6 through 16, 18 through 22, and 27 through 35, are considered by Appellant as a single

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group. Accordingly, it is deemed to be true that claims 1, 2, 6 through 16, 18 through 22, and 27 through 35 stand or fall together.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

EP 0,621,563 A1

Long

10-1994

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Because claims 1, 2, 6 through 16, 18 through 22, and 27 through 35 stand or fall together, the examiner's ground of rejection has been directed to the broadest one of the appeal claims, i.e. Claim 15 in this instant appeal.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Long (EP 0,621,563).

**W.R.T. Claim 15:**

Long discloses a system for producing and weighing mailing units, comprising:  
a controller having a processor and a memory containing the weight of each of the components (predetermined) (see Fig. 2; also Supra Claim 1);

a printer (as controlled by the controller 25) for printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

a reader (27, 66) for reading the identifier and providing the identifier to the controller;

a movable track (see Figs. 1a-2);

a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);

a moving mechanism to move the inserts from the track and into an envelope (see Id.); and

wherein the controller determines the components of the mailing unit based on the identifier (see Fig. 2; the reader 27, 66 scans the identifier) and the weight of the mailing unit based on the weights of the components (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

**(11) Response to Argument**

In response to appellant's argument that **Long** does not disclose each and every element in the independent Claim 15, the examiner respectfully traverses.

**Long** discloses a system comprising: a controller having a processor and a memory containing the weight of each of the components (predetermined) (Fig. 2; databases 88, 90); a printer (as controlled by the controller 25) (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40); a reader (27, 66); a movable track (see Figs. 1a-2); a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b); and a moving mechanism.

In response to applicant's argument that the printed identifier or information in **Long** referenced by the examiner is clearly not printed in **order to** later identify components of the mailing unit and, conversely, the appellant's printer prints after that

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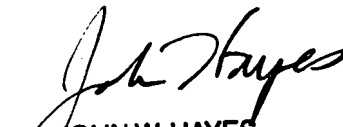
one of the components has been provided to system **in order to** identify the components of the mailing unit, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is respectfully noted by the examiner that the identifier (information in a data record) in **Long** is used to determine which inserts should be stuffed into an envelope and an indication of the weight of the envelope with enclosures, based on the known weight of the envelope, card and letter sheet and the known weights of the selected inserts. Therefore, the system of **Long** can identify the components of the mailing unit based on its identifier and reading thereof, as claimed by the appellant.

Accordingly, **Long** structure is capable of performing the intended use the prior art structure is capable of performing the intended use, then it meets the claim 15.

For the above reasons, it is believed that the rejections should be sustained.

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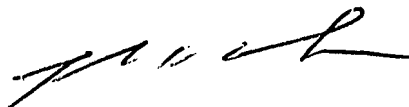
Respectfully submitted,



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July 18, 2007

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